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EXAMINER

DUONG, OANH L

ART UNIT PAPER NUMBER

2155

DATE MAILED: 03/29/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/706,975

Applicant(s)

TAM ET AL.

Examiner

Oanh Duong

Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 03 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 06 March 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-7,9-15,17 and 18 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-7,9-15,17 and 18 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 14 November 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
- Paper No(s)/Mail Date 01/15/04, 04/28/04 & 04/03/06

- 4) ☐ Interview Summary (PTO-413)
- Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

1. Claims 1-7, 9-15 and 17-18 are presented for examination.

Claims 8 and 16 have been canceled.

Continued Examination Under 37 CFR 1.114

2. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 03/06/2006 has been entered.

Claim Objections

3. Claim 1, 6 and 12 are objected to because of the following informalities:

Regarding claim 1, it is not clear that the feature "a first mobile telephone service provider" in line 2, and "a first mobile telephone service provider" in line 4 refer to the same or different telephone service provider. For purpose of examination, examiner assumes they refer to the same telephone service provider.

Similarly, it is not clear that the feature "a second mobile telephone service provider" in lines 2-3, and "a second mobile telephone service provider" in line 7 refer to the same or different telephone service provide. For purpose of examination, examiner assumes they refer to the same telephone service provider.

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Regarding claim 6, it is not clear that the feature "an initiating mobile telephone service provider" in line 2, and "an initiating mobile telephone service provider" in line 4 refer to the same or different telephone service provider. For purpose of examination, examiner assumes they refer to the same telephone service provider.

Similarly, it is not clear that the feature "a destination mobile telephone service provider" in lines 2-3, and "a destination mobile telephone service provider" in line 7 refer to the same or different telephone service provide. For purpose of examination, examiner assumes they refer to the same telephone service provider.

Regarding claim 12, it is not clear that the feature "an initiating carrier" in line 2, and "an initiating carrier" in lines 3-4 refer to the same or different carrier. For purpose of examination, examiner assumes they refer to the same telephone service provider.

Similarly, it is not clear that the feature "a destination carrier" in line 2, and "a destination carrier" in line refer to the same or different carrier. For purpose of examination, examiner assumes they refer to the same carrier.

Appropriate correction is required.

Claim Rejections - 35 USC § 112

4. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

5. Claims 9 and 12 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter

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which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

The feature "sending a short message service message to the destination carrier to *alert* an intended recipient of a received MMS message *when the MMS message received cannot be delivered as received from the initiating mobile telephone service provider*" found no support in the specification of the instant application. Examiner respectfully requests applicant to specifically point out where in the specification of the instant application describing the above feature.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 1-4, 6, 11, 13, and 14 are rejected under 35 U.S.C. 103(a) as being unpatentable over **White** et al. (hereafter, White), U.S. Patent No. **6,021,126**, in view of **Volach**, U.S. Pub. No. **2003/0158902 A1**.

Regarding claim 1, **White** teaches a method for providing service interoperability between a first telephone service provider (i.e., end office/carrier 13, Fig. 3) and a second phone service provider (i.e., end office/carrier 15, Fig. 3), comprising:

receiving a message from a first telephone service provider (i.e., end office 13) (i.e., *white discloses Gateway router receives a query message from end office 13*, col. 11 lines 40-50);

query a telephone number portability database (i.e., database 35, Fig. 3) that identifies a corresponding mobile telephone service provider for each of a plurality of telephone numbers to determine an identity of a second mobile telephone service provider (i.e., end office 15, Fig. 3) to which the message is intended to be sent (i.e., *the query is transmitted and seeks from the database 35 the local routing number (LRN). The end office 13 uses the LRN to route the call to the end office 15*, col. 11 line 40-col. 12 line 30).

White does not teach query a carrier profile repository to access a carrier profile for the second mobile telephone service provider, the carrier profile including information regarding an multimedia message service (MMS) format acceptable to the second mobile telephone service provider; transcoding the MMS message in accordance with the carrier profile to generate a transcoded MMS message; and sending the transcoded MMS message to the second mobile telephone service provider.

Volach teaches a system wherein multi-media communications to wireless devices is provided (see abstract). Volach teaches query a profile repository to access a profile (i.e., device capabilities 42, Fig. 5) for device, the profile including information regarding an multimedia message service (MMS) format acceptable to the device (i.e., *access to information regarding the type of device to which the communication is being*

*sent. Hence the correct format for the communication content is determined and addressed, page 3 paragraphs [0037] and [0039], page 4 paragraphs [0043]-[0055]); transcoding the MMS message in accordance with the profile to generate a transcoded MMS message (i.e., *transcode a communication appropriate for display on a computer to a communication deliverable efficiently on a mobile telephone or an audio device, or it may transcode formats of the communication content, depending on the content type, device capabilities, and user profile*, page 4 paragraphs [0045]-[0055]); and sending the transcoded MMS message to the device (i.e., *the results of transcoding may be routed to external system and onto a client device 20/destination server*, Fig. 5 page 5 paragraph [0068]).*

It would have been obvious to one of ordinary skill in the art at the time of the invention was made to incorporate the step of transcoding MMS message based upon a destination device's profile of **Volach** in the process of providing service between providers/carriers in **White**. One would be motivated to do so to allow for the best delivery according to various criteria, including quality, time, user preference and operator/provider configuration requirements (**Volach**, page 6 paragraph [0074]).

Regarding claim 2, **White** teaches the method of claim 1, wherein the first telephone service provider is an initiating message carrier (i.e., originating/initiating end office/carrier, col. 12 lines 29-30).

White does not explicitly teach multimedia messaging service (MMS).

Volach teaches multi-media messaging service (MMS) (page 1 paragraph [0007]).

It would have been obvious to one of ordinary skill in the art at the time of the invention was made to combine the teachings of **White** to include the multimedia messaging service as taught by **Volach** because it would allow sending of multimedia messages including text, images, audio and video (**Volach**, page 1 paragraph [0007] lines 5-6).

Regarding claim 3, **White** teaches the method of claim 1, wherein the second telephone service provider is a message destination carrier (i.e., the originating end office 15 routes the call to the end office 15, col. 12 lines 29-30).

White does not explicitly teach multimedia messaging service (MMS).

Volach teaches multi-media messaging service (MMS) (page 1 paragraph [0007]).

It would have been obvious to one of ordinary skill in the art at the time of the invention was made to combine the teachings of **White** to include the multimedia messaging service as taught by **Volach** because it would allow sending of multimedia messages including text, images, audio and video (**Volach**, page 1 paragraph [0007] lines 5-6).

Regarding claim 4, **White** teaches the method of claim 1.

White does not explicitly teach preliminarily determining whether the step of transcoding is necessary.

Volach teaches preliminarily determining whether the step of transcoding is necessary (page 6 paragraph [0072]).

It would have been obvious to one of ordinary skill in the art at the time of the invention was made to combine the teachings of **White** to include the step of preliminarily determining whether the step of transcoding is necessary as taught by **Volach** because it allow message to be transcoded as necessary, thereby providing optimized delivery (**Volach**, page 6 paragraph 0074)).

Regarding claim 6, **White** teaches a method for providing service interoperability between an initiating telephone service provider (i.e., end office/carrier 13, Fig. 3) and a destination phone service provider (i.e., end office/carrier 15, Fig. 3), comprising:

receiving a message from an initiating phone service provider (i.e., end office 13) (i.e., *white discloses Gateway router receives a query message from end office13, col. 11 lines 40-50*);

query a number portability database (i.e., database 35, Fig. 3) that identifies a corresponding mobile telephone service provider for each of a plurality of telephone numbers to determine an identity of a destination mobile telephone service provider (i.e., end office 15, Fig. 3) to which the message is intended to be sent (i.e., *the query is transmitted and seeks from the database 35 the local routing number (LRN). The end*

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office 13 uses the LRN to route the call to the end office 15, col. 11 line 40-col. 12 line 30).

White does not teach query a carrier profile repository to access a carrier profile for the destination mobile telephone service provider, the carrier profile including information regarding an multimedia message service (MMS) format acceptable to the destination mobile telephone service provider; determining, based on the carrier profile and a format of the MMS message received from the initiating mobile telephone service provider, whether the format of the MMS message received from the initiating mobile telephone service provider must be modified to be effectively received by a subscriber of the destination mobile telephone service provider and, if so, transcoding the MMS message in accordance with the carrier profile to generate a transcoded MMS message; and sending one of (i) the MMS message received from the initiating mobile telephone service provider and (ii) the transcoded MMS message to the destination mobile telephone service provider.

Volach teaches a system wherein multi-media communications to wireless devices is provided (see abstract). Volach teaches query a profile repository to access a profile (i.e., device capabilities 42, Fig. 5) for a destination device, the profile including information regarding an multimedia message service (MMS) format acceptable to the device (i.e., *access to information regarding the type of device to which the communication is being sent. Hence the correct format for the communication content is determined and addressed*, page 3 paragraphs [0037] and [0039], page 4 paragraphs [0043]-[0055]); determining, based on the profile and a format of the MMS message

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received from a initiating device, whether the format of the MMS message received from the initiating device must be modified to be effectively received by a subscriber of the destination device and, if so, transcoding the MMS message in accordance with the profile to generate a transcoded MMS message (i.e., *transcode a communication appropriate for display on a computer to a communication deliverable efficiently on a mobile telephone or an audio device, or it may transcode formats of the communication content, depending on the content type, device capabilities, and user profile*, page 4 paragraphs [0045]-[0055]); and sending one of (i) the MMS message received from the initiating device and (ii) the transcoded MMS message to the destination device (i.e., *the results of transcoding may be routed to external system and onto a client device 20/destination server*, Fig. 5 page 5 paragraph [0068]).

It would have been obvious to one of ordinary skill in the art at the time of the invention was made to incorporate the step of transcoding MMS message based upon a destination device's profile of **Volach** in the process of providing service between providers/carriers in **White**. One would be motivated to do so to allow for the best delivery according to various criteria, including quality, time, user preference and operator/provider configuration requirements (**Volach**, page 6 paragraph [0074]).

Regarding claim 11, White teaches the method of claim 6.

White does not teach delivering the MMS message to a legacy system belonging to the destination mobile telephone service provider.

Volach teaches delivering the MMS message to a legacy system belonging to the destination mobile telephone service provider (page 3 paragraphs [0035]-[0037]).

It would have been obvious to one of ordinary skill in the art at the time of the invention was made to incorporate the teachings of White to include the step of delivering the MMS message to a legacy system belonging to the destination mobile telephone service provider as taught by Volach because it would allow multi-media messages including text, images, audio and video to be sent between users, even when the users are connected through different carriers (Volach, page 1 paragraph [0007]).

Regarding claim 13, **White** teaches the method of claim 1, **White** does not explicitly teach multimedia messaging service (MMS).

Volach does not teach multi-media messaging service (MMS) message is originated from a mobile telephone.

Volach teaches multi-media messaging service (MMS) message is originated from a mobile telephone (page 3 paragraphs [0031]-[0032]).

It would have been obvious to one of ordinary skill in the art at the time of the invention was made to combine the teachings of **White** to include the multimedia messaging service originated from a mobile telephone as taught by **Volach** because it would allow multimedia messages including text, images, audio and video to be communicated between users, even when the user are connected through different carriers (**Volach**, page 1 paragraph [0007] lines 5-6).

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Regarding claim 14, **White** teaches the method of claim 1, wherein the first and second carriers are mobile telephone service providers (col. 7 lines 66-67).

7. Claims 5 and 7 are rejected under 35 U.S.C. 103(a) as being unpatentable over **White**, in view of **Volach**, and further in view of **Shaw**, U.S. Pub. No. **2004/0162818** A1.

Regarding claim 5, **White** teaches the method of claim 1, contains a plurality of carriers (i.e., plurality carriers, col. 6 line 42).

the combination of teachings of **White and Volach** does not explicitly teach the carrier profile repository contains carrier profiles.

Shaw teaches profile storage wherein profile information is accessed for the source of the service request (see abstract). **Shaw** teaches profile repository contains profiles (page 1 paragraph [0010] and page 3 paragraphs [0036] [0047 and page 4 paragraphs [0058]-[0070]).

It would have been obvious to one of ordinary skill in the art at the time of the invention was made to incorporate the profiles, taught by **Shaw**, in the combination of teachings of **White and Volach** because it would allow network elements and/or service providers to exchange profile information in order to cooperatively improve service (**Shaw**, page 7 paragraph [0107]).

Regarding claim 7, **White** teaches the method of claim 6, contains a plurality of carriers (i.e., plurality carriers, col. 6 line 42).

the combination of teachings of **White and Volach** does not explicitly teach the carrier profile repository contains carrier profiles.

Shaw teaches profile storage wherein profile information is accessed for the source of the service request (see abstract). **Shaw** teaches profile repository contains profiles (page 1 paragraph [0010] and page 3 paragraphs [0036] [0047 and page 4 paragraphs [0058]-[0070]).

It would have been obvious to one of ordinary skill in the art at the time of the invention was made to incorporate the profiles, taught by **Shaw**, in the combination of teachings of **White and Volach** because it would allow network elements and/or service providers to exchange profile information in order to cooperatively improve service (**Shaw**, page 7 paragraph [0107]).

8. Claims 9, 10, 12, 15, 17, and 18 is rejected under 35 U.S.C. 103(a) as being unpatentable over **White**, in view of **Volach**, and further in view of **Heck et al.** (hereafter, **Heck**), U.S. Pub. No. **2005/0064883 A1**.

Regarding claims 9, **White** teaches the method of claim 6.

The combination of teachings of **White and Volach** does not explicitly teach sending an SMS message to the destination device to alert an intended recipient of a received MMS message when the MMS message received cannot be delivered as received from the initiating mobile telephone service provider.

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Heck teaches sending a short message service (SMS) message to the destination device to alert an intended recipient of a received MMS message when the MMS message received cannot be delivered as received from the initiating mobile telephone service provider (page 2 paragraph [0019] and page 4 paragraphs [0030], [0032]-[0033]).

It would have been obvious to one of ordinary skill in the art the time of the invention was made to modify the combination of teachings of **White and Volach** to send a short message service (SMS) message to the destination device to alert an intended recipient of a received MMS message when the MMS message received cannot be delivered as received from a sender as in **Heck**. One would be motivated to do so to enable a notification message to be transmitted to the recipient, thereby allow the recipient to be aware of message that is awaiting delivery to the recipient (**Heck**, page 11 paragraph [0011]).

Regarding claim 10, White teaches the method of claim 6, sending a message to the destination carrier (col. 12 lines 29-39).

White does not teach sending an email to the destination mobile telephone service provider to alert an intended recipient of a received MMS message.

Heck teaches sending an email to the destination device to alert an intended recipient of a received MMS message (page 2 paragraphs [0019], [0022] and page 4 paragraphs [0030], [0032]-[0033]).

It would have been obvious to one of ordinary skill in the art the time of the invention was made to modify the combination of teachings of White and Volach to send a short message service (SMS) message to the destination device to alert an intended recipient of a received MMS message when the MMS message received cannot be delivered as received from a sender as in Heck. One would be motivated to do so to enable a notification message to be transmitted to the recipient, thereby allow the recipient to be aware of message that is awaiting delivery to the recipient (Heck, page 11 paragraph [0011]).

Regarding claim 12, this claim is the system for performing the corresponding method claims 6 and 9, discussed above, same rationale of rejection is applicable.

Regarding claim 15, **White** teaches the method of claim 6, **White** does not explicitly teach multimedia messaging service (MMS).

Volach does not teach multi-media messaging service (MMS) message is originated from a mobile telephone.

Volach teaches multi-media messaging service (MMS) message is originated from a mobile telephone (page 3 paragraphs [0031]-[0032]).

It would have been obvious to one of ordinary skill in the art at the time of the invention was made to combine the teachings of **White** to include the multimedia messaging service originated from a mobile telephone as taught by **Volach** because it would allow multimedia messages including text, images, audio and video to be

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communicated between users, even when the user are connected through different carriers (**Volach**, page 1 paragraph [0007] lines 5-6).

Regarding claim 17, **White** teaches the system of claim 12, **White** does not explicitly teach multimedia messaging service (MMS).

Volach does not teach multi-media messaging service (MMS) message is originated from a mobile telephone.

Volach teaches multi-media messaging service (MMS) message is originated from a mobile telephone (page 3 paragraphs [0031]-[0032]).

It would have been obvious to one of ordinary skill in the art at the time of the invention was made to combine the teachings of **White** to include the multimedia messaging service originated from a mobile telephone as taught by **Volach** because it would allow multimedia messages including text, images, audio and video to be communicated between users, even when the user are connected through different carriers (**Volach**, page 1 paragraph [0007] lines 5-6).

Regarding claim 18, **White** teaches the system of claim 12, wherein the initiating and destination carriers are mobile telephone service providers (col. 7 lines 66-67).

Conclusion

8. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

- a. Tang et al., U.S. Pub. No. 2005/0259652 A1, disclose method for forwarding multimedia messages between multimedia messaging service center.
- b. Patel, USPN 6,047,056, discloses accessing the LNP database in order to retrieve the routing information for a ported subscriber.
- c. Ratilainen et al., U.S. Pub. No. 2004/0053604 A1, disclose performing portability function to the network node controlling the service.
- d. Laumen et al., EP 1,225,416 A1, disclose storing and accessing MMS (multimedia Messaging Service) information.
- e. Coulombe et al., U.S. Pub. No. 2002/0169823 A1 discloses transcoding content communicated in a network.

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Oanh Duong whose telephone number is (571) 272-3983. The examiner can normally be reached on Monday- Friday, 9:30PM - 6:00PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Saleh Najjar can be reached on (571) 272-4006. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Oanh Duong
March 19, 2006